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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,631	10/27/2003	Kevin L. Corcoran	021919-001110US	6410

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EXAMINER
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BLAKE, CAROLYN T

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/695,631

Applicant(s)

CORCORAN ET AL.

Examiner

Carolyn T Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on January 10, 2005 is acknowledged.

### ***Drawings***

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application due to the following:

- All features should be referenced using numbers, not words. All words should be deleted from the drawings.
- It is improper to use two lead lines with one reference number when referring to one feature on several views. For example, lead lines are pointing to both FIG 2 and FIG 3. Appropriate correction is required.
- FIGS 2, 4, and 6 all denote a reference for cross section "A-A." However, a different cross section would result from each. Appropriate corrections, such as renaming the cross sections, are required.
- The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "113" and "118" have both been used to designate the throat.
- The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of enlarged areas on the cutting component (claim 11) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The disclosure is objected to because of the following informalities:
- Page 3, line 2: The term "bear" should be changed to - -bare- -.
  - Page 5, line 18: "The punch die is made a steel rule" should be changed to - -The punch die is made of steel rule- -.
  - In addition, the disclosure is replete with run-on sentences, incorrect comma use, and other grammatical errors. The disclosure should be carefully proofread.

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Appropriate corrections are required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The cutting component with a plurality of enlarged areas is not mentioned in the disclosure.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not understood how the cutting component includes a plurality of enlarged areas.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, and 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nehr (799,928).

Regarding claim 1, Nehr discloses a punch comprising: a cutting component (B) that is configured to a shape; a cutting component housing (A) that houses the cutting component (B), the cutting component (B) extending beyond the cutting component housing (A); and a handle component (11) extending from the cutting component housing (A) for positioning the punch.

Regarding claim 2, Nehr discloses the cutting component (B) is a die configured to a shape.

Regarding claim 7, Nehr discloses the cutting component housing (A) includes an enlarged area. The housing at 17 where it encircles the cutter is considered an enlarged area because it is enlarged relative to the cutter.

Regarding claim 8, Nehr discloses the enlarged area generally encircles the cutting component (B).

Regarding claim 9, Nehr discloses the enlarged area encircles the cutting component (B).

Regarding claim 10, Nehr discloses the enlarged area is located adjacent the cutting component (B).

Regarding claim 11, to the extent Applicant shows a plurality of enlarged areas, Nehr discloses the cutting component (B) includes a plurality of enlarged areas.

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Regarding claim 12, the handle component (11) includes a grip.

11. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Chen (6,189,220). Chen discloses a punch assembly comprising: a cutting component (44) that is configured to a shape; a cutting component housing (A) (40) that houses the cutting component (44), the cutting component (40) extending beyond the cutting component housing (A); a handle component (34) extending from the cutting component housing (A) (40) for positioning the punch; and a cutting pad (64) adapted to be positioned so that the cutting pad (64) is adjacent the cutting component (44) when in use.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehr as applied to claim 2 above, and further in view of Smith (3,250,163). Nehr fails to disclose the material and method of manufacturing the die. However, Smith discloses a die made from steel rule (34), wherein the steel rule (34) has a first end and a second end; the first end and the second end are aligned and secured by welding. The ends of the steel rule (34) are welded to a plate (36). See col. 2, lines 48-50. Smith further discloses the advantages of using a steel rule die include low cost, high effectiveness, and longevity (col. 1,

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lines 12-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the die of the Nehr device from steel rule, as disclosed by Smith, because steel rule is inexpensive, effective, and long lasting.

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nehr as applied to claim 12 above, and further in view of Hellinger et al (4,388,743). Nehr discloses a handle/grip (11), but fails to disclose the grip comprises a material that absorbs shock. However, Hellinger et al disclose a tool wherein the tool handle component (15) includes a grip (23) that slides on the handle (15) and is manufactured from a material (rubber) that absorbs shock. This material choice makes the handle comfortable for the operator and resists slipping that could occur during use. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a grip that is inserted on the handle and is manufactured from a shock-absorbing material, as disclosed by Hellinger et al, on the Nehr device for the purpose of operator comfort and sliding resistance.

15. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nehr in view of Hellinger et al. Nehr discloses a punch assembly comprising: a handle end and a opposite punch holding end; the punch holding end holding a punch die (B) which extending beyond a cutting side of the punch holding end. Nehr fails to disclose a sleeve. However, McNab discloses a tool with a handle (15) that includes a sleeve (23). This material choice makes the handle comfortable for the operator and resists slipping that could occur during use.



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Note the sleeve (23) is relatively thin and, if used with the Nehr device, appears to be half the distance the punch die extends from the cutting side of the punch. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a grip that is inserted on the handle and is manufactured from a shock-absorbing material, as disclosed by Hellinger et al, on the Nehr device for the purpose of operator comfort and sliding resistance.

16. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nehr in view of Hellinger et al as applied to claim 21 above, and further in view of Bourbeau (5,561,903). The Nehr-Hellinger et al combination fails to disclose indicia identifying the cutting side of the punch assembly. However, Bourbeau discloses a tool wherein the tool action is indicated by indicia (62). The indicia allow the operator to use the proper side of the tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide indicia, as disclosed by Bourbeau, on the Nehr-Hellinger et al combination for the purpose of indicating the action side of the tool.

17. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nehr in view of Hellinger et al as applied to claim 21 above, and further in view of Smith. Although Nehr discloses the die is made from steel (col. 2, line 33), the Nehr-Hellinger et al combination fails to disclose the punch die is made from steel rule. However, Smith discloses a die made from steel rule (34). Smith further discloses the advantages of using a steel rule die include low cost, high effectiveness, and longevity (col. 1, lines 12-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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manufacture the die of the Nehr-Hellinger et al combination from rule, as disclosed by Smith, because steel rule is inexpensive, effective, and long lasting.

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sohni (30,236), Gelder (2,823,716), Cosman (1,520,856), and Patenadue (5,230,156) disclose punches with cutting components and handles.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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CB

February 17, 2005



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